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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,831	02/12/2004	Trent D. Galloway	MB6245.001	5694

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EXAMINER

LEGESSE, NINI F

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,831

Applicant(s)

GALLOWAY, TRENT D.

Examiner

Nini F. Legesse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-9 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's response to the Non-Final office action of 09/22/04 is acknowledged on 03/25/05.

Please note that the PTO-892 from the first Non-Final Office action and Applicant's IDS of 02/12/04 signed by examiner is re-submitted since they do not appear to be in IFW.

Abstract

The abstract of the disclosure is objected to because it is over 150 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The expression " a training club selected for the group of golf clubs consisting of drivers and irons" in lines 3-4 of claim 1 is new matter. The original specification does not specifically define as to which types of clubs the instant invention is limited too. Thus, limiting the claim to "consist of drivers and

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irons" only is new matter. In addition, it is noted that Figs. 1 and 3 of the instant application show an iron club. Therefore, the training device to be limited to drivers is new matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Hull et al. (US Patent No. 5,082,279).

Regarding claim 1:

- Hull discloses iron type golf clubs (see column 1, lines 64-68).
- A flexible hollow shaft (10, all golf club shafts are flexible to some degree);
- A first weight including a compact distribution of a plurality of disconnected particles (32) secured internally within the shaft between a head end of the shaft where the shaft attaches to a club head and a grip end of the shaft where a training club grip attaches to the shaft (see Fig. 6);
- A club head (18) attached to the head end of the shaft by a hosel (base section 12); and
- A training club grip (16) secured to an upper end of the shaft.

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Regarding claim 2:

The valves (30) are considered as a first and plugs (see Figs 6-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4- 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hull.

Regarding claim 4, Hull does not explicitly state if the weight extends from approximately 4 inches above the hosel to approximately 2 inches below a bottom of the club grip as stated in claim 4. At the time the invention was made, it would have been an obvious to a person of ordinary skill in the art to locate the weight at any dimension because Applicant has not disclosed that extending the weight from approximately 4 inches above the hosel to approximately 2 inches below a bottom of the club grip provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either of the weight spacing as taught by Hull or

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the claimed weight spacing because both spacing perform the same function of assisting golfers to improve their golfing skills.

Regarding claims 5 and 8, Hull fails to explicitly disclose the weight measurement to be 4 and 6 ounces or 7.5 grams. However he states that the variable weight distribution is completely controllable and could be determined by the users own discretion and that the user can decide the proper weight distribution (see column 4, lines 18-23). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide any weight including 4 and 6 ounce or 7.5 grams in order to provide an adjustable weight balance device that is suitable for all gender and for all abilities of different players. In addition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide any amount of weight including a weight of 4 and 6 ounce or 7.5 grams because, these specific weights are not deemed critical since Applicant has not disclosed the purpose or the advantage of this particular weight in his specification.

Regarding claim 6, Hull also fails to disclose a weight particle that is #9 buckshot.

Regarding the #9 buckshot, at the time the invention was made, it would have been an obvious alternative material choice to a person of ordinary skill in the art to use #9 buckshot or, for that matter, any other weight material because Applicant has not disclosed that the use of this material provide an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would

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have expected Applicant's invention to perform equally well with the flowable material of Hull or the claimed #9 buckshot because both materials perform the same function of adding adjustable weight to a golf club.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hull in view of Green, Jr. (US Patent No. 5,205,552).

Hull states that the weight could be flowable material such as ball bearings or sand or other materials but he fail to disclose wherein the weight is a brass. However, the use of brass as a weight element in a golf club is not new because Green discloses the use of brass as a weight in a golf club head assembly (item 15 and in column 3, line 63, the weight unit is stated as a brass). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a brass weight in the Hull's device as taught by Green since brass is a relatively cheap material compared to other metals.

Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mather et al. (US 5,152,527) in view of Ballmer (US Patent No. 3,625,513).

- Mather discloses iron type golf clubs (see Fig. 3).
- A flexible hollow shaft (100, all golf club shafts are flexible to some degree);
- A first weight including a compact distribution of a plurality of disconnected particles (L) secured internally within the shaft between a head end of the shaft where the shaft attaches to a club head and a grip end of the shaft where a club grip attaches to the shaft (see Figs. 3 and 5);

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- A club head (200) attached to the head end of the shaft by a hosel; and
- A training club grip (300) secured to an upper end of the shaft.

Mather discloses the invention as recited above but fails to include a second weight that is secured internally within the shaft wherein this second weight is flush with the head end of the shaft. However, Bakkner teaches the use of weight as claimed (32). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a second weight in the Mather device at the second end of the shaft as taught by Ballmer in order to provide the desired swing weighting for the club as stated in column 2, lines 57-60 of the Ballmer reference.

Allowable Subject Matter

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: none of the prior art of record discloses a lower plug that is an EPDM tapered plug and a second upper plug that is a silicon gel, when affixed in the manner claimed in combination with the other recited features.

Response to Arguments

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

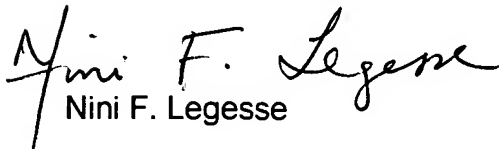
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (571) 272-4412. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571) 272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nini F. Legesse

06/06/05